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EXAMINER

KALINOWSKI, ALEXANDER G

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 05/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/270,710

Applicant(s)
Glaser

Examiner
Alexander Kalinowski

Art Unit
3626



– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 25, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 3626

DETAILED ACTION

1. Claims 1-22 are presented for examination. Applicant filed an amendment on 8/22/2001 amending claim 1 and adding claim 22. Applicant further filed a request for continued examination on 3/13/2002. Applicant also filed an amendment on 3/13/2002, amending claims 1-3, 10, 16, 20, and 21. Applicant further filed arguments on 8/28/2002. Applicant further filed a request for reconsideration on 2/25/2003. After careful consideration of Applicant's arguments, the Examiner maintains the grounds of rejection of claims 1-22 based on 35 USC 103 and the instant office action is a final rejection of claims 1-22 based on 35 USC 103.

Response to Arguments

2. With respect to claim 1, Applicant argues that the Examiner provided an inconsistent analysis of the limitation "associating a preselected advertisement with said communication within the data processing system with the sending party", that in one instance the Examiner contended that the Goldschmitt reference disclosed this limitation and that in another instance the Examiner contended that the Goldschmitt reference did not disclose this limitation (see paper No. 16, page 2). The Examiner disagrees. The Examiner notes that nowhere in the previous office action did the Examiner consider the limitation of "associating a preselected advertisement with said communication within the data processing system with the sending party" nor did Applicant claim this limitation. The Examiner further notes that the limitation as claimed in claim 1 is "associating a preselected advertisement with said communication within the user managed data processing

Art Unit: 3626

system associated with the sending party". As noted in the previous office action, the Examiner used the combination of Goldschmitt, The Mail and Kamakura to disclose this limitation. The Examiner, in the previous office action, stated that the Goldschmitt reference discloses "associating a preselected advertisement with said communication within the data processing system **associated** with the sending party" (see Paper No. 15, page 3, paragraph number 4). The Examiner notes the language of "associating a preselected advertisement to the communication" feature and the "the data processing system associated with the sending party" does not necessarily limit the "associating the advertisement ..." feature to occur within the sender's data processing system. The "associating the advertisement ..." step occurs within the data processing system **associated** with the sending party. According to the Merriam Webster's Collegiate Dictionary, 10th edition, the term associated means "to join or connect together". The mail server of Goldschmitt is connected to or joined to (i.e. associated with) the sender, in particular the sender's data processing system via a network connection. The mail server is a data processing system that is associated with the sending party insofar as the mail server is joined or connected to the sender's data processing system. Therefore, Goldschmitt discloses "associating a preselected advertisement with said communication within the data processing system associated with the sending party". Furthermore, the Examiner stated that Goldschmitt and The Mail did not explicitly disclose "associating the preselected advertisement with said communication within the **user managed** data processing system (Paper No. 15, page 4). Neither Goldschmitt nor The Mail explicitly disclose that the associating step occurred within a **user managed** data processing

Art Unit: 3626

system. Specifically, the Goldschmitt and The Mail references did not explicitly disclose that the data processing system associated with the sending party was **user managed**. Instead, the Examiner relied on Kamakura to disclose this feature. Therefore, Applicant's arguments directed to Goldschmitt and the feature of "associating a preselected advertisement with said communication within the data processing system with the sending party" is nonpersuasive for the reasons stated above.

Applicant further argues that Goldschmitt does not teach or disclose the claimed steps of "associating a preselected advertisement within the user-managed data processing system". However, as noted above, the Examiner did not rely on the Goldschmitt reference to disclose this step. Instead, the Examiner relied on the Kamakura reference to disclose this feature. Therefore, Applicant's argument is nonpersuasive.

Applicant also argues that Kamakura does not explicitly disclose "associating the preselected advertisement with said communication within the **user managed** data processing system". The Examiner disagrees. The Examiner notes that Goldschmitt disclosed associating the preselected advertisement with the communication in the data processing system associated with the sending party as explained above. Kamakura was used by the Examiner to disclose that the data processing system is a **user managed** data processing system. Kamakura discloses transmitting advertisements within e-mails to specified recipients (i.e. distribution of advertisements information ... by electronic mail)(see abstract, col. 5, lines 28-31 and col. 6, lines 56-61). The data processing system in Kamakura (i.e. information providing apparatus)(Fig. 1) is

Art Unit: 3626

a user managed system in that the sender directs or manages the data processing system to send advertisements in emails only to those recipients who meet the sender's desired designation (i.e. information transmission requirement)(col. 4, lines 35-44). Therefore, Kamakura discloses "associating the preselected advertisement with said communication within the **user managed** data processing system" and Applicant's arguments to claim 1 are nonpersuasive.

3. With respect to claims 4, 5, 6, 9, 15, 16, 18 and 19, Applicant argues that since the claims are dependent on claim 1 and since claim 1 is allowable based on Applicant's arguments, these claims are allowable based on their dependency to claim 1, However, since the Examiner found Applicant's arguments to claim 1 to be nonpersuasive as explained above, Applicant's argument to the rejection of claims 4, 5, 6, 9, 15, 16, 18 and 19 are nonpersuasive for the same reasons.

4. With respect to claim 2, Applicant argued that Goldschmitt does not teach the step of offering the sender an option to become an advertiser and enabling, if the offer is accepted, a procedure within the data processing system by which the preselected advertisement is associated with the communication. The Examiner disagrees. As admitted by Applicant, Goldschmitt offers free email messaging. In order for a sender to use the Goldschmitt free email system, the sender accepts the Goldschmitt offer which includes appending an advertisement to sender's email. If the sender declines the offer, the user would presumably still be able to use email messaging for a fee as pointed out in Goldschmitt in the Background of the Invention section describing the existing prior art e mail systems . If the user accepts the offer of free email, the Goldschmitt system is activated and a preselected advertisement is attached to the email within the data processing

Art Unit: 3626

system. Furthermore, there is no reason why the user after using the free email system would not be able to opt out of being an advertiser. Therefore, Applicant's arguments directed to claim 2 are nonpersuasive.

5. With respect to claims 8, 10-13 and 17, Applicant argues that since the claims are dependent on claim 2 and since claim 2 is allowable based on Applicant's arguments, these claims are allowable based on their dependency to claim 1, However, since the Examiner found Applicant's arguments to claim 2 to be nonpersuasive as explained above, Applicant's argument to the rejection of claims 8, 10-13 and 17 are nonpersuasive for the same reasons.

6. With respect to claim 3, Applicant argued that Goldschmitt does not disclose the feature wherein the advertisement is associated with at least one of software or hardware operable with the data processing system. The Examiner disagrees. As discussed above, the email server 18 is a data processing system associated with the sender (as disclosed by Goldschmitt). Furthermore, as discussed above, the remote server is user managed (as disclosed by Kamakura). As admitted by Applicant, the advertisement can be associated with the sponsor communication network, which is a part of the email server, and computer equipment that is used by the server or the sponsor communication network may be subject to advertisement (see Fig. 6) Therefore, Applicant's arguments with respect to claim 3 are not persuasive.

7. With respect to claim 20, Applicant argues that although signature blocks are well known and hypertext links and graphics are well known, and since Goldschmitt does not disclose modifying the signature block to include advertisement information, that modifying the signature

Art Unit: 3626

block to include advertisement information is not well known as evidenced by the lack of a disclosure and that Examiner's contention that it would have been obvious to modify the signature block to include advertisement information is purely hindsight and is unsupportable. The Examiner disagrees. First, the Examiner did not use official notice in the rejection of claim 20. Claim 20 was rejected by the combination of Goldschmitt, Kamakura and Uomini references See Paper No. 15, pages 9-11). It appears that Applicant's arguments are directed to grounds of rejection of claim 20 that were used by the Examiner in a previous office action but are no longer the outstanding grounds of rejection of pending claim 20. The claimed features of claim 20 that Applicant argues were not disclosed by any references were disclosed by the combination of Goldschmitt, Kamakura and Uomini. Furthermore, motivation to combine the references was found directly within the cited references. Therefore, Applicant's arguments directed to claim 20 are nonpersuasive.

8. With respect to claim 21, Applicant argues that it would not be possible for the free email system of Goldschmitt to have access and to manipulate the information in the signature file stored in the user managed data processing system of the sending party as contended by the Examiner. The Examiner disagrees. First, the Examiner notes that the grounds of rejection of base claim 20 are based on the combination of Goldschmitt, Kamakura and Uomini. The absence of any of Applicant's arguments with respect to the Kamakura and Uomini references leads the Examiner to suspect Applicant's arguments are not directed to the outstanding rejection of claims 20 and 21 but to prior grounds of rejection of claims 20-21 that are no longer outstanding and

Art Unit: 3626

have been withdrawn. In addition, the claimed limitation of claim 21 is to the limitation of “said signature file associated with an e-mail client operating on said user managed data processing system **in association with** the sending party”. As explained in claim 1 above, the Applicant’s use of the phrase in association with the sending party does not limit the user managed data processing system to be the sending party’s data processing system. The user managed data processing system may be **any** processing system that is networked with the sending party’s data processing system. Applicant’s argument seems to suggest that the user managed data processing system is the sending party’s data processing system. However, the claimed limitation does not support this interpretation of claim 21. Therefore, Applicant’s arguments to claim 21 are nonpersuasive.

9. With respect to claim 22, Applicant argues that the arguments of claim 1 apply to claim 22 based on the claim’s dependency to claim 1 and Applicant also argues that Uomini does not disclose the claimed limitations of claim 1. The Examiner disagrees. As explained in claim 1 above, the combination of Goldschmitt, The Mail and Kamakura disclosed the limitations of claim 1. Uomini was not used to disclose the claimed limitations of claim 1. The Examiner used Uomini to disclose the claimed feature of claim 22 of “associating said preselected advertisement with said communication further comprises associating a personal testimonial by said sending party thereby lending credibility to said preselected advertisement”. Therefore, Applicant’s arguments directed to claim 22 are nonpersuasive.

Art Unit: 3626

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/24213 A1, Goldschmitt et al. (hereinafter Goldschmitt) in view of "World Wide Watch" (hereinafter The Mail) and Kamakura et al., Pat. No. 6,047,310.

As per claim 1, Goldschmitt discloses a method of transmitting an advertisement from a sending party to a receiving party (see abstract and Fig. 4) comprising the steps of:

initiating a communication from a user-managed data processing system associated with the sending party (see Fig. 1 and page 8, line 26 - page 9, line 2);

associating a preselected advertisement with said communication within the data processing system associated with the sending party (page 9, lines 8-13)

transmitting said communication with said preselected advertisement therein to the recipient (see abstract)

Goldschmitt does not explicitly disclose

embedding the advertisement within the communication.

However, The Mail discloses transmitting said communication with said preselected advertisement embedded therein to the recipient (i.e. inserting advertisements into user's e-mail

Art Unit: 3626

messages)(see page 1, abstract). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include embedding the advertisement within the communication within the Goldschmitt system in order to provide an alternative source of revenue (page 2, lines 29-33).

Goldschmitt and The Mail do not explicitly disclose associating the preselected advertisement with said communication within the user-managed data processing system.

However, Kamakura discloses associating the preselected advertisement with said communication within the user-managed data processing system (i.e. the processing unit 2 designates the type of commodities and services that the receiver want from the category information ... The distributing unit 3 distributes the advertisement information corresponding to the type to the receiver ... distribution of advertisement information to the receiver terminal by electronic mail ...)(col. 5, lines 11-39). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include associating the preselected advertisement with said communication within the user-managed data processing system as disclosed by Kamakura within the Goldschmitt and The Mail combination for the motivation of distributing to a user (i.e. receiver) advertisement information that the user wishes to receive (col. 5, lines 17-20).

As per claim 2, Goldschmitt discloses the method of claim 1, further comprising the steps of: offering to the sender an option of becoming an advertiser (i.e. offer to provide free email

Art Unit: 3626

service) and enabling, if the offer is accepted, a procedure within said user managed data processing system by which said preselected advertisement is associated with the communication (see abstract).

As per claim 3, Goldschmitt discloses the method of claim 1, wherein the advertisement is associated with at least one of software or hardware operable with the user managed data processing system (i.e. email message or software)(see abstract).

As per claim 4, Goldschmitt discloses the method of claim 1, wherein the communication is at least one of e-mail, facsimile, voice-over-IP, voice-over-Internet, voice mail, video mail, video conferencing, and an animated presentation (i.e. email)(see abstract).

As per claim 5, Goldschmitt discloses the method of claim 1, wherein the advertisement is sent for a preselected time period (i.e. between 5:00 PM and 7:00 PM)(page 6, lines 1-11).

As per claim 6, Goldschmitt discloses the method of claim 1, wherein the advertisement is sent up to a pre-selected number of times)(i.e. certain number of times during the day)(page 6, lines 1-11).

Art Unit: 3626

As per claim 7, Goldschmitt discloses the method of claim 1, wherein said preselected advertisement is electronically obtained from a third party data processing system (i.e. advertiser storage data files unit 24)(see Fig. 1 and page 8, lines 14-15).

As per claim 8, Goldschmitt discloses the method of claim 2, wherein the user is compensated for accepting the offer to become an advertiser (i.e. user receives free email)(see abstract).

As per claim 9, Goldschmitt discloses the method of claim 1, wherein the advertisement is at least one of visual and aural (i.e. graphics)(page 9, lines 23-29).

As per claim 10, Goldschmitt does not explicitly disclose the method of claim 2, wherein the advertisement is incorporated in setup software for one of software and hardware on said user managed data processing system.

However, the Examiner takes official notice that it was well known to provide advertisements within setup software for software or hardware in the computer arts. The purpose was to alert the customer of other products owned by the manufacturer that might be of interest to the customer. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 2, wherein the advertisement is incorporated

Art Unit: 3626

in setup software for one of software and hardware within the Goldschmitt system for the motivation stated above.

As per claim 11, Goldschmitt discloses the method of claim 2, wherein means for sending the communication comprises at least one of an e-mail client, a facsimile system, a voice-over-IP system, a voice-over-Internet system, a voice mail system, a video mail client, and a video teleconferencing system (i.e. email)(see abstract).

As per claim 12, Goldschmitt discloses the method of claim 2, further comprising offering to a recipient of the communication and advertisement an option of being an advertiser (see abstract).

As per claim 13, Goldschmitt discloses the method of claim 12, wherein said step of offering to a recipient of the communication and advertisement an option of being an advertiser includes fraud avoidance means for reducing or eliminating fraud associated with the transaction (see abstract).

As per claim 14, Goldschmitt discloses the method of claim 7, wherein said preselected advertisement is electronically obtained from a third party data processing system using the Internet (page 8, lines 5-8).

Art Unit: 3626

As per claim 15, Goldschmitt discloses the method of claim 1, wherein the advertisement is displayed to a recipient during a period of at least one of before, during and after the communication (page 8, lines 10-13 and page 9, lines 1-7).

As per claim 16, Goldschmitt discloses the method of claim 1, wherein the user managed data processing system is at least one of a computer and telephone (see Fig. 1 and col. 8, lines 1-13).

As per claim 17, Goldschmitt discloses the method of claim 2, wherein the advertisement is embedded in the communication by a third party (i.e. email messaging center 18)(page 8, lines 14-25).

As per claim 18, Goldschmitt discloses the method of claim 1 wherein said preselected advertisement is determined at least in part by the recipient's demographic (i.e. profile match information identifying certain demographic information)(page 8, lines 14-25).

As per claim 19, Goldschmitt discloses the method of claim 18 wherein said demographic is at least one of location, language, gender, age, income, and physical handicap (i.e. profile match information identifying certain demographic information)(page 8, lines 14-25).

Art Unit: 3626

12. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldschmitt in view of Kamakura and Uomini..

As per claim 20, Goldschmitt discloses a method of transmitting an electronic communication including an advertisement from a user managed data processing system associated with a sending party to a data processing system associated with a receiving party (see abstract) comprising the steps of:

transmitting an electronic communication using the data processing system associated with the sending party to the data processing system associated with the recipient (see abstract).

Goldschmitt does not explicitly disclose

transmitting the electronic communication including said advertisement using the user managed data processing system associated with the sending party.

However, Kamakura discloses associating the preselected advertisement with said communication within the user-managed data processing system (i.e. the processing unit 2 designates the type of commodities and services that the receiver want from the category information ... The distributing unit 3 distributes the advertisement information corresponding to the type to the receiver ... distribution of advertisement information to the receiver terminal by electronic mail ...)(col. 5, lines 11-39). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include transmitting the electronic communication including said advertisement using the user managed data processing system associated with the

Art Unit: 3626

sending party as disclosed by Kamakura within Goldschmitt for the motivation of distributing to a user (i.e. receiver) advertisement information that the user wishes to receive (col. 5, lines 17-20).

Goldschmitt and Kamakura do not explicitly disclose

locating a data file containing signature information on the data processing system associated with the sending party, said signature information being appended to electronic communications originating from the user managed data processing system associated with the sending party;

modifying information stored within said signature file to include an advertisement; and
said electronic communication including said information stored within said signature file including said advertisement.

However, Uomini discloses an electronic messaging system that attaches information to the mail messages (see abstract and col. 1, lines 8-10). A signature block (i.e. context data) is used to transmit information to the recipient and is attached to the sender's message (see col. 5, lines 6-18). Furthermore, Uomini discloses the signature block may contain business information (i.e. advertisement)(col. 5, lines 10-12). The motivation for including an advertisement within the signature block was to attach information to the mail message (col. 1, lines 8-10 and col. 3, lines 1-5). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include locating a data file containing signature information on the data processing system associated with the sending party, said signature information being appended to electronic communications originating from the data processing system associated with the sending party,

Art Unit: 3626

modifying information stored within said signature file to include an advertisement and said electronic communication including said information stored within said signature file including said advertisement as disclosed by Uomini within the Goldschmitt and Kamakura system for the motivation stated above.

As per claim 21, Goldschmitt does not explicitly disclose the method of claim 20 wherein said signature file is associated with an e-mail client operating on said user managed data processing system associated with the sending party.

However, Goldschmitt discloses attaching preselected advertisements to an email message of a recipient wherein said preselected advertisement is electronically obtained from a third party data processing system (page 8, lines 5-8). The Examiner takes official notice that it was well known in the computer arts to use signature files within user managed data processing systems. The motivation for embedding the advertisements within a signature file at the third party data processing system allows the system to add advertisements to the portion of the email message that is always present thereby simplifying the efficiency and cost of the system. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 20 wherein said signature file is associated with an e-mail client operating on said data processing system associated with the sending party within the Goldschmitt system for the motivation stated above.

Art Unit: 3626

13. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldschmitt, The Mail and Kamakura as applied to claim 1 above, and further in view of Uomini, Pat. No. 6,018,761.

As per claim 22, Goldschmitt, The Mail and Kamakura do not explicitly disclose the method of claim 1 where associating said preselected advertisement with said communication further comprises associating a personal testimonial by said sending party thereby lending credibility to said preselected advertisement.

However, Uomini discloses associating said preselected advertisement with said communication further comprises associating a personal testimonial by said sending party thereby lending credibility to said preselected advertisement (see Fig. 2b and 2c). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 1 where associating said preselected advertisement with said communication further comprises associating a personal testimonial by said sending party thereby lending credibility to said preselected advertisement within the Goldschmitt, The Mail and Kamakura combination for the motivation of obtaining message context information for the recipient regardless of whether it is provided or not by the sender (col. 1, lines 8-10 and col. 2, lines 56-67).

Art Unit: 3626

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

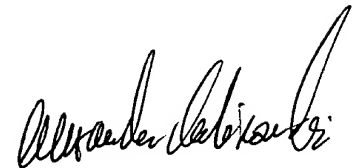
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this

Art Unit: 3626

group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th Floor, receptionist.

A handwritten signature in black ink, appearing to read "Alexander Kalinowski". The signature is fluid and cursive, with a large, sweeping initial 'A'.

Alexander Kalinowski

Patent Examiner

Art Unit 3626

May 4, 2003

Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at www.uspto.gov or call the Office of Patent Legal Administration at (703) 305-1622.